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February 24, 1997

Assistant Commissioner for Patents
Washington, D.C. 20231

Re: U.S. Patent Application
Appl. No. 08/377,450; Filed: January 24, 1995
For: Helical Scan Transport for Single Reel Tape Cartridge
Inventor: HOGE *et al.*
Our Ref: 1411.0210001

RECEIVED

FEB 28 1997

GROUP 2500

Sir:

The following documents are forwarded herewith for appropriate action by the U.S. Patent and Trademark Office:

1. Appellants' Brief in Reply to Examiner's Answer Under 37 C.F.R. § 1.193(b) (in triplicate); and
2. One return post card.

It is respectfully requested that the attached post card be stamped with the date of filing of these documents and returned to our courier.

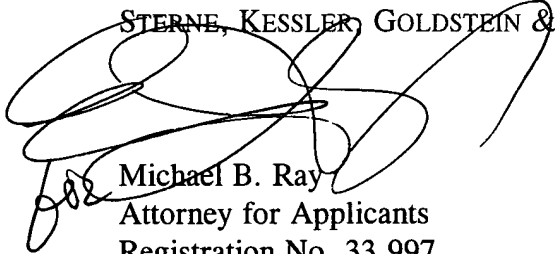
The Commissioner is hereby authorized to charge any fee deficiency, or credit any overpayment, to our Deposit Account No. 19-0036. If extensions of time under 37 CFR §1.136 other than those otherwise provided for herewith are required to prevent abandonment of the present patent application, then such extensions of time are hereby petitioned, and any fees

Timothy Schulte, Esquire
February 24, 1997
Page 2

therefor are hereby authorized to be charged to our Deposit Account No. 19-0036. A duplicate copy of this letter is enclosed.

Respectfully submitted

STERNE, KESSLER, GOLDSTEIN & FOX, P.L.L.C.

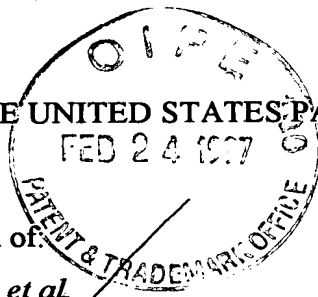


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Enclosures

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE



In re application of:

HOGE *et al.*

Appln. No.: 08/377,450

Filed: January 24, 1995

For: **Helical Scan Transport for Single
Reel Tape Cartridge**

Art Unit: 2512

Examiner: Korzuch, W.R.

Atty Docket: 1411.0210001

#21
3/4/97
J. Proctor

**APPELLANTS' BRIEF IN REPLY TO EXAMINER'S ANSWER
UNDER 37 CFR§ 1.193(b)**

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Assistant Commissioner of Patents
Washington, DC 20231

Sir:

Pursuant to the provisions of 37 CFR§ 1.193(b), Appellants submit the following in reply to the Examiner's new points of argument in the Examiner's Answer dated December 24, 1996. This Reply Brief is submitted in triplicate.

Preliminary Matters

Claims 1, 3-5, 7-9 and 11-12 are pending in the instant case. Claims 2, 6 and 10 are canceled. Claims 1, 3-5, 7-9 and 11-12 are finally rejected and are on appeal in the instant case.

Basis for Entry of this Reply Brief

The Examiner indicates on page 7 of his Answer that there are no new grounds of rejection. However, the Examiner has changed his reasoning for the rejection under 35 U.S.C. §103. The Examiner, for the first time, refers to substitution of the linear threading mechanism of Godsoe as an "art recognized equivalent" of the arcuate threading mechanism of Shimizu. Thus, this Reply Brief is being submitted to address the Examiner's new reasoning.

Reply to the Examiner's New Points of Argument

1. *The linear tape threading system of Godsoe and the arcuate threading mechanism of Shimizu are NOT art recognized equivalents*

The Examiner has improperly asserted that the linear threading mechanism of Godsoe and the arcuate threading mechanism of Shimizu are art recognized equivalents. The Examiner has provided no basis, teaching or evidence to support the allegation of equivalence. The Examiner merely states:

One of ordinary skill in the art at the time of the invention would have been motivated to provide the tape loading system of Shimizu et al with the linear tape threading system as taught by Godsoe et al in lieu of the tape threading system as taught by Shimizu et al since they are art recognized equivalent threading systems.

(Examiner's Answer, pages 4 and 5) It appears that this assertion is being made so that the Examiner need not show any motivation in the prior art for making the substitution in an attempt to reconstruct the claimed invention. The Examiner's rejection, however, is flawed for two reasons.

First, the structures of Godsoe and Shimizu are not art recognized equivalents because the two systems cannot be combined. The substitution of the Godsoe mechanism into the Shimizu system results in the destruction of the intent, purpose and function of Shimizu reference. The "constant force" spring, pin, spool and channel of Godsoe cannot be substituted for the *mutually dependent* series of cams, pins, levers and drive motor of Shimizu. The intricate, *mutually dependent* relationship between the elements of Shimizu is illustrated by the complex operation of the transport system. (Shimizu, column 9, line 64 through column 12, line 27) The substitution of the "constant force" spring, pin, spool and channel of Godsoe would render the insertion/ejection, pivotally engaging and threading and tape cartridge ejecting structure of the Shimizu reference inoperative, thereby destroying the intended functionality of the reference. Accordingly, the Examiner's unsupported assertion that the mechanisms of Godsoe and Shimizu are art recognized equivalents is improper and should be withdrawn.

Second, assuming *arguendo* that the threading mechanisms of Shimizu and Godsoe are art recognized equivalents, the substitution of the linear threading mechanism of Godsoe for the arcuate threading mechanism of Shimizu *does not* result in Appellants' claimed invention. Appellants' invention is a novel combination of elements, claimed in a specific arrangement. Appellants' claimed arrangement of elements is not taught or suggested by the mere substitution of the linear threading mechanism of Godsoe for the arcuate threading mechanism of Shimizu. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

To date, the Examiner has provided no motivation to make the combination of Shimizu and Godsoe that would result in Appellants' claimed invention. The Examiner can suggest such a combination only after reading Appellants' own novel disclosure. With the benefit of hindsight and using Appellants' claims as a blueprint, the Examiner makes the combination of references. It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. *In re Gorman*, 933 F.2d 982, 987, 19 USPQ2d 1885, 1888 (Fed. Cir. 1991).

CONCLUSION

Claims 1, 3-5, 7-9 and 11-12 are finally rejected solely under 35 U.S.C. § 103. Appellants have shown that the rejection is improper both as to its basis and as to its application to the claims at issue. For the reasons set forth in this Reply Brief and the original Brief on

Appl. No. 08/377,450
REPLY BRIEF

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Appeal, the Board should reverse the Final Rejection and order the Examiner to pass this application to allowance and issue.

Respectfully submitted,

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Date: 2/24/97

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